

REMARKS

The Office Action dated March 31, 2004, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

The Applicants wish to thank the Examiner for allowance of claims 3-8.

Claims 2 and 9 are pending in the present application and are respectfully submitted for consideration.

As a preliminary matter, Applicants submit that the finality of the Office Action is improper, and therefore request the withdrawal of the Final Office Action. According to MPEP § 706.07(a), a second action on the merit on any application will not be made final if it includes a rejection, on newly cited art, of any claim not amended by applicant in spite of the fact that other claims may have been amended to require newly cited art. In the second Office Action, which was made Final, the Examiner made a rejection on newly cited art against claims 2 and 9, which were not amended. Since claims 2 and 9 were not amended, and newly cited art was applied against claims 2 and 9, the rejection on this second action cannot be made final. Therefore, the Applicants respectfully request that the Examiner withdraw the finality of the rejection of all of the claims in this Office Action.

Claims 2 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yuen et al. (U.S. Patent No. 6,477,705, "Yuen"). Claim 2 depends from claim 9. The Applicants traverse the rejection and respectfully submit that claims 2 and 9 recite subject matter that is neither disclosed nor suggested by Yuen.

Yuen discloses a television having a PIP format for display of program related information such as television program listings from a program schedule data base in the background and moving, real time images of a program selected from the displayed listings in the PIP window. All the text of the background information lies outside the PIP window. As the viewer of Yuen selects a particular program from the display of current television program listings by means of a cursor or a code number, the corresponding program automatically appears in the PIP window.

The Applicants respectfully submit that Yuen fails to disclose or suggest at least the limitation of “a second compositor for compositing the first compression video signal and the second compression video signal such that a broadcast video and a program guide are displayed on different screen portions of a monitor.” In contrast, Yuen discloses the display of a particular video program and the program schedule by PIP format, which is neither comparable nor analogous to the compression and composite means of displaying a broadcast video and a program guide on different screen portions of a monitor.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim . . . the identical invention, specifically, [t]he identical invention must be shown in as

complete detail as contained in the claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). As Yuen fails to disclose a second compositor for compositing the first compression video signal and the second compression video signal such that a broadcast video and a program guide are displayed on different screen portions of a monitor, as arranged in the claims, claims 2 and 9 are not anticipated by Yuen, nor are claims 2 and 9 obvious in view of Yuen.

In view of the above, Applicants respectfully submit that each of claims 2 and 9 recites subject matter that is neither disclosed nor suggested in the cited prior art. The Applicants also submit that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 2 and 9 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants’ undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together

with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. 100341-09004.

Respectfully submitted,

A handwritten signature in black ink, reading "Rhonda L. Barton". The signature is fluid and cursive, with a large, stylized "R" and "B".

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